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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/834,237

04/12/2001

Prathima Agrawal

1258-US

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11/04/2004

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EXAMINER

CHANG, RICHARD

ART UNIT

PAPER NUMBER

2663

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/834,237	Applicant(s) AGRAWAL ET AL.	
	Examiner Richard Chang	Art Unit 2663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,9,11 and 15-24 is/are rejected.
- 7) ☒ Claim(s) 3-8, 10 and 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/12/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The disclosure is objected to because of the following informalities in the specification: The **serial number** for a concurrently filed application, entitled "Methods and systems for a generalized mobility solution using a dynamic tunneling agent", is **missing** (See page 1, line 6). Appropriate corrections are required.

### *Double Patenting*

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-2, 9, 15-17 and 18-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the corresponding claims 1, 4, 9, 15-17 and 19-25 of copending Application No. 09/834,234. Although the conflicting claims are not identical, they are not patentably distinct from each other because the independent claims 1 and 17 of the instant application merely broaden the scope of the corresponding independent copending claims 1 and 17 by eliminating the reference element

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"registering the mobile node with the second agent such that the mobile node is provided a unique globally reachable address different from a home address of the mobile node" of the corresponding independent copending claims 1 and 17.

It would have been obvious to one skilled in the art to eliminate the cited reference element because that will simplify the steps to operate the system. Moreover, it has been held that the omission an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1,9, 11, 17 and 18-20 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US patent No. 6,697,354 ("Borella et al.").

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Regarding claim 1, Borella et al teach a system and method for facilitating intra-domain mobility (See Fig. 15) comprising the steps and means of

providing a home subnet (212 as a first network) that includes a home agent (208 as first agent) including the home network address (location information) on the home subnet (212) about a mobile node (210) (See Fig. 15, Col 19, lines 62-64),

providing a foreign network that includes two or more sub networks (foreign subnet 218 and foreign subnets other than foreign subnet 218) and a foreign agent (216 as second agent) (See Fig. 15, Col 20, lines 65-67), and

registering the mobile node (210) with the foreign agent (216) (See Fig. 15, Col 19, line 64 to Col 20, line 3), such that

the mobile node (210) can roam from any of the sub network (218) to another sub network without communicating to the home agent (208 as first agent) information about the transition and without communicating to the foreign agent (216 as second agent) information about a security association between the mobile node (210) and home agent (208 as first agent) (See Fig. 16, Col 20, lines 65-67).

Regarding claim 17, Borella et al further teach that the agent is based on the programmable CPU and the method is performed by CPU executed operations (See Col 6, lines 16-24).

Regarding claims 9 and 18, Borella et al further teach a layered Mobile IP stack (42) for distributed network access translation on all agents and inherently the mobile IP is a protocol for the network layer communication (See Fig. 2, Col 7, lines 14-21).

Regarding claim 11, Borella et al further teach that

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the mobile node's home network (212 as first network) receives data packets (236 as communication addressed to) for the mobile node (210),

the home agent (208 as first agent) intercepts the data packets (236 as communication),

the home agent (208 as first agent) forwards the tunneled data packets (238 as communication) to the foreign agent (216 as second agent),

the foreign agent (216 as second agent) routes data packets (240 as communication) to the mobile node (210). (See Fig. 16, Col 20, lines 25-49).

Regarding claim 19, Borella et al further teach that a first network includes a home subnet (212) for a mobile node (210) (See Fig. 15, Col 19, lines 5-7).

Regarding claim 20, Borella et al further teach that a second network includes a foreign subnet (218) for a mobile node (210) (See Fig. 15, Col 20, lines 18-20).

### ***Allowable Subject Matter***

6. Claims 3-8 and 10, 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if no art rejection can be applied.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Chang whose telephone number is (571) 272-3129. The examiner can normally be reached on Monday - Friday from 8 AM to 5 PM.

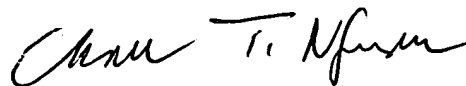
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau T Nguyen can be reached on (571) 272-3126. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*RKC*  
rkc

Richard Chang  
Patent Examiner  
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